

DEC 16 2008

Application Serial No. 10/564,771
Reply to office action of September 16, 2008

PATENT
Docket: CU-4657

REMARKS/ARGUMENTS

Reconsideration is respectfully requested.

Claims 1-16 are pending before this amendment. No claims are amended in this paper, as none is deemed necessary for the reasons below. No new matter has been added.

In the office action (page 2), claims 1-16 stand objected under 35 U.S.C. §112, ¶2, as being indefinite.

The applicants respectfully reassert their arguments that the term "standard location information" is not a generic term and is sufficiently well defined within the specification in accordance with MPEP 2111.01(IV) which states, inter alia (emphasis added):

An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "'set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)). **Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings").**

In the previously filed response of June 17, 2008, the applicants provided numerous citations within the specification that clearly define the term "standard location information." Beginning on page 12 of the specification, the "standard location

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information" is described in numerous ways illustrating exactly what "standard location information" represents. Accordingly, the applicants have clearly set forth the meaning of the term "standard location information" throughout the specification with such specificity that one of ordinary skill in the art would understand the term in accordance with MPEP 2111.01(IV). Accordingly, the applicants respectfully request withdrawal of the rejection.

In the office action (page 3), claims 1-4, 6-8 and 14-15 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2003/0108205 (Joyner). The "et al." suffix is omitted in a reference name.

The applicants respectfully **disagree**.

At the outset, the applicants respectfully note that the examiner's choice of reply in response to this paper is limited to one of the following, because the applicants have not introduced any new grounds necessitating an additional search (i.e., no claims are amended herein) in this response:

- (1) issuing a Notice of Allowance; and
- (2) issuing a non-final office action citing a new reference.

The applicants respectfully request issuance of a Notice of Allowance in the next action in view of the detailed reasons below.

The applicants duly note the examiner's "Response to Arguments" in the office action, page 6; however, the applicants respectfully submit that the office action has again misinterpreted the teachings of Joyner and respectfully reassert their arguments set forth in the previous office action of June 17, 2008. The examiner's characterization

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that "[s]ince the compression to an MPEG-21 format from another form [0026] is clearly taught in the reference [Joyner], DID extraction is inherently taught by Joyner et. al" is a complete misunderstanding of the disclosure of Joyner.

As set forth in previous responses, the applicants maintain that Joyner does not teach anything in regards to a --DID-- and accordingly cannot teach any steps referring to the --DID--. The examiner asserts that the mere mention of MPEG-21 alone in paragraph [0026] of Joyner somehow teaches "file generation", "addressing", and "teaches the use of a DID" (Office Action page 7-8). In paragraph [0026] of Joyner, MPEG-21 is referenced as one of a plethora of "digital compression standards" that may be provided to the server 102 of Joyner by the **content providers 104** (Joyner [0026]). That is, the listing of "digital compression standards" is a listing of file types that a content provider 104 may provide to the invention of Joyner for distribution. Joyner has absolutely nothing to do with formation of an MPEG-21 file as alluded to by the examiner. Joyner explicitly states in paragraph [0026] (emphasis added):

"Typically, the **content provider 104** will convert the content from an analog to a digital format (process 110), if necessary, and compress the content (process 112). The **content provider 104** then **provides the content to the server 102** in a compressed digital format."

Joyner clearly explains that the content that is distributed according to the "System and Method for Providing Encrypted Data to a Device" of Joyner is provided by the **content providers 104** in a finished format. That is, Joyner's system and method acts on the finished files from the content providers. A finished file format provided from the **content providers 104** would be an already generated MPEG-21 file among other files. The applicants are perplexed as to how the examiner can claim that a statement

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describing a system that receives a file somehow discloses the generation of that file.

There is no evidence anywhere within Joyner to support this conclusion.

Joyner discloses a system and method for providing encrypted data to a device (Joyner [0024]). More specifically, Joyner discloses a **delivery** system that improves delivery of encrypted data (Joyner [0024]). Referring to FIG. 1 of Joyner, the content delivery system 100 references the content providers 104 (Joyner FIG. 1). The content providers 104 provide data in the form of numerous formats to the server 102 (Joyner [0026]; FIG. 1). The data provided from the content providers 104 is converted and compressed **prior** to being supplied to the server 102, which delivers the content to the clients 106 (Joyner [0026]). According to FIG. 1 and the disclosure of Joyner, by the time the data is provided to the server 102 a file format is already formed by the content providers 104, including MPEG-21 (Joyner [0026]). That is, the server 102 of Joyner plays no part in --generat[ing] a media file based-- from a DID.

The examiner cites a Wikipedia article stating, "Digital Item Declaration (DID) is a language standardized in MPEG-21" (Office Action page 7). The examiner is correct, however the examiner has not fully considered the term DID. The DID language, as referenced by the examiner, is used to form a DID file that is the framework for a MPEG-21 file. According to the technical report issued by the International Organization for Standardization (ISO) that describes the MPEG-21 file format, the Digital Item Declaration is described as follows:

5.2 MPEG-21 Part 2 – Digital Item Declaration

"The purpose of the Digital Item Declaration (DID) specification is to describe a set of abstract terms and concepts to form a useful model for defining Digital Items. Within this model, a Digital Item is the digital representation of "a work",

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and as such, it is the thing that is acted upon (managed, described, exchanged, collected, etc.)”

- ISO/IEC TR 21000-1:2001(E) Part 1: Vision, Technologies and Strategy (ISO/EIC 2004-11-01)

Therefore, although the examiner is correct in characterizing DID as representing a schema language, it also a file that defines a digital item, which is the basis for the MPEG-21 framework.

The examiner alleges that Joyner teaches compression “to an MPEG-21 format from another form” (Office Action page 7). This is not what Joyner teaches. Joyner teaches that a file may be provided from a content provider to a server 102 in a compressed format and that one of those formats may be MPEG-21 (Joyner [0026]). Nowhere does Joyner state how an MPEG-21 file is compressed or formed. The allegation that because a content provider may provide a compressed MPEG-21 file format to a server can somehow teach “MPEG-21 file generation and its addressing” is absolutely without merit.

The presently claimed invention claims a method that includes --extracting a corresponding media resource according to reference information of the media resource **recorded in the DID**--. Considering Joyner does not teach a --DID--, the applicants are perplexed as to how the examiner can allege that Joyner extracts --reference information-- from --the DID--. The conclusive statement by the examiner that because a compressed MPEG-21 file is provided from a content provider to a server and therefore “DID extraction is inherently taught” finds no support (Office Action 7).

In response to the applicants previously filed argument that Joyner does not perform any file generation as clearly recited in claim 1 of the present invention, the

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examiner states that a file converted from one format to another constitutes file creation as stated in paragraph [0026] of Joyner (Office Action page 7). Once again, the applicants respectfully note to the examiner that paragraph [0026] of Joyner does not teach converting one file format to another. Paragraph [0026] of Joyner clearly states that the content providers 104 can provide content in a compressed format to the server 102 of the Joyner invention. Paragraph [0026] of Joyner then proceeds to give example of types of file that may be supplied to the server 102 from the content providers 104. The examiner is construing this paragraph as somehow teaching the presently claimed invention.

Claim 1 of the present invention claims --generat[ing] the media file-- by --filing the meta data box and the media data box--. The --meta data box-- and the --media data box-- are populated with information extracted from the DID. Therefore, reading the language of claim 1 --generat[ing] the media file-- without giving deference to how the media file is generated is clearly in error. According to the argument presented by the examiner, there is no support that --filing the meta data box and the media data box-- generates the media file as in claim 1 of the presently claimed invention. Rather, the examiner broadly states that "converting an existing file," teaches file generation. The examiner's blanket statement does not adequately support this assertion.

In response to the applicants previously filed arguments that storage device 116 is not the same as the --media data box-- of the present invention, the examiner relies on paragraph [0029] and FIGS. 4A and 4B. FIG. 1 of the present invention, which depicts the media data box Mdat 120, illustrates a conceptual diagram of the WD1.1-based ISO media file format. The ISO media file format shown in FIG. 1 is the basic

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framework of an MPEG file. This is very different than the invention of Joyner where data is stored in data storage device 116.

The examiner cites paragraph [0029] of Joyner teaching the storage of data (Office Action page 7). Paragraph [0029] of Joyner teaches that "encrypted content along with the encryption key " can be stored "in a database or data storage device 116" (Joyner [0029]). The database or data storage device 116 is **not** an ISO media file format, but rather is a separate piece of hardware to store a finished file format for later retrieval. The disclosure of the present invention clearly states that the media data region 130 is a part of the MPEG-21 or MPEG-4 file format (specification page 8, lines 1-3). That is, the --media data box-- is a part of the file and is not external to the file as in Joyner. This is further illustrated in the claims where the media data box is --filed-- to --generate the media file--. Accordingly, the examiner's characterization that storage of a file in a "database or data storage device 116" can teach the media data box 120 is without merit.

Finally, the examiners broad statement that "[t]he accepting, storing and distribution of content as taught in Joyner et al. [0026] clearly teaches the use of a DID, since one of the formats listed is MPEG-21 which has DID language defined within" does not support the disclosure of a DID as alleged. The examiner's overly broad statement is a conclusive statement without providing any support. Joyner teaches a distribution framework for providing encrypted files to clients. The mere listing of an MPEG-21 file as one of many possible file formats cannot teach the use of a DID. The utilization of an MPEG-21 file does not inherently teach the process for extracting and generating an MPEG-21 file from a DID file. The examiner has failed to distinctly point

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out how Joyner teaches a DID other than an overly broad assertion that any mention of an MPEG-21 file also teaches the generation of an MPEG-21 file from a DID. Therefore, if the examiner continues to make such an assertion, the applicants respectfully request the examiner provide specific examples of how Joyner teaches a --DID-- as in the presently claimed invention.

Accordingly, Joyner can in no way teach the presently claimed invention as they are directed to wholly different subject matter. In the broadest sense, the present invention describes a process by which to generate an MPEG-21 file. In the context of Joyner, the method of the presently claimed invention would be used by the content providers 104 to generate the MPEG-21 file that is provided to the distribution system of Joyner. That is to say, the presently claimed invention describes a method of forming an MPEG-21 file for distribution while Joyner is directed to distributing a finished file that may include an MPEG-21 file.

Accordingly, the applicants respectfully request withdrawal of the current rejection and earnestly solicit an indication of allowable subject matter with respect to independent claims 1, 8, 14, and 15 since Joyner does not disclose each and every limitation of the presently claimed invention including the --DID-- and the --generat[ion] of the media file--.

As to claims 2-5, 9-13, and 16, the applicants respectfully assert that these claims are allowable at least since they depend from independent claims 1, 8, 14, and 15 for at least the reasons set forth above. Withdrawal of the rejection is respectfully requested.

For the reasons set forth above, the applicants respectfully submit that claims 1-

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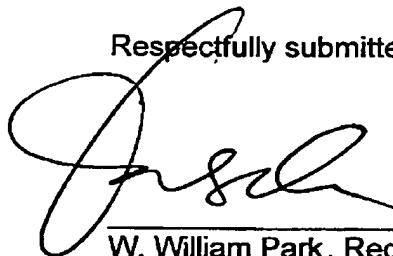
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16, pending in this application, are in condition for allowance over the cited references. Accordingly, the applicants respectfully request reconsideration and withdrawal of the outstanding rejections and earnestly solicit an indication of allowable subject matter.

This amendment is considered to be responsive to all points raised in the office action. Should the examiner have any remaining questions or concerns, the examiner is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

Dated: Dec. 16, 2008



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